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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/581,563

06/02/2006

Michael Gavin Proctor

71,049-012

6206

27305

7590

02/19/2008

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EXAMINER

MOORE, MARGARET G

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

02/19/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/581,563	<b>Applicant(s)</b> PROCTOR ET AL.	
	<b>Examiner</b> Margaret G. Moore	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 to 9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 to 9 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/12/07</u> .   | 6) <input type="checkbox"/> Other: ____.                          |

1. Claims 1 to 9 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The breadth of "substantially free" is unclear. The term "substantially" is subjective and thus one cannot determine the breadth of this claim. Clarification is particularly important in view of the teachings in Cornelius et al., which include a reinforcing filler. It is unclear if such an amount is excluded from the claims or not.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 to 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joseph et al. in view of Woerner et al.

Joseph et al. teach hydrophobic clay, preferably kaolin. See column 1, line 50, through column 2, line 25. The silanes taught on column 2, lines 50 and on, embrace those in claims 3 and 4. The top of column 1 indicates that such treated clay can be used as a filler in silicone rubber compositions but fails to specifically teach a silicone rubber as claimed.

Woerner et al. teach a silicone rubber composition that requires a non-reinforcing filler such as a clay. This reference teaches a silicone rubber composition that meets the claimed requirements of (i) and (iii) as claimed. See for instance the siloxane polymer on column 3, line 15, and the various curing agents on column 3, line 55, through column 4, line 55. This teaches the limitations of claims 2, 6, 7 and 11.

Thus one having ordinary skill in the art, in an effort to determine an operable silicone rubber for use in the clay filled silicone rubber of Joseph et al., would have been motivated to select one within the breadth of Woerner et al. since the latter reference

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teaches known silicone rubbers that can be used to form clay filled silicones. In this manner the skilled artisan would have found the claimed invention obvious.

4. Claims 1 to 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woerner et al. in view of Cornelius et al. or Joseph et al.

Woerner et al. teach silicone rubber compositions that contain the required components (i) and (iii). See for instance the abstract. This reference generally teaches that surface treated clay can be present (column 3, lines 30 to 35) but fails to specifically teach kaolin surface treated clay.

Both Cornelius et al. and Joseph et al. teach silane surface treated clay which is preferably kaolin. See for instance column 1, lines 60 to 65, in Cornelius and column 1, lines 55 and on, of Joseph et al. The benefits of adding such treated clays include improved heat stability (column 1, line 59 of Cornelius et al.) and improved moisture sensitivity (column 1, line 9 of Joseph et al.). In addition, from the teachings in the Background of the Invention in Cornelius et al., one can expect improved mechanical and dynamic properties.

Thus, in view of the teachings in Woerner et al. which suggest the addition of surface treated clay, one having ordinary skill in the art would have been motivated to use a surface treated kaolin since this is a preferred surface treated clay taught by the prior art, as evidenced by Cornelius et al. and Joseph et al. In this manner the instant claims are rendered obvious.

5. Prowell et al. is cited as being of general interest. This reference does not qualify as prior art in the instant application. At the time of this office action, the Examiner was unsuccessful in her attempt to locate a copy of the Union Carbide brochure noted in Cornelius and Prowell. She is still trying to locate this reference.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-

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272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Margaret G. Moore/  
Primary Examiner, Art Unit 1796

mgm  
2/13/08